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Docket No.: 192403US55X

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

RE: Application Serial No.: 09/584,182
Applicants: David SUDA, et al.
2nd RCE Filed: March 3, 2003
For: APPARATUS AND METHOD FOR BAGGING AN ITEM
Group Art Unit: 3721
Examiner: HARMON, C.

SIR:

Attached hereto for filing are the following papers:

Appeal Brief under 37 C.F.R. § 1.192 w/ Appendix (in triplicate)

Our **credit card payment form** in the amount of **$330.00** is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: :

David SUDA, et al. : EXAMINER: HARMON, C.

SERIAL NO: 09/584,182 :

2nd RCE FILED: March 3, 2003 : GROUP ART UNIT: 3721

FOR: APPARATUS AND METHOD FOR BAGGING AN ITEM :

APPEAL BRIEF UNDER 37 C.F.R. § 1.192

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

The Appellants hereby appeal the final rejection of Claims 1 and 3-8 as set forth in the final Office Action dated August 12, 2003, and the Advisory Action dated November 18, 2003.

I. REAL PARTY IN INTEREST

The real party in interest is CertainTeed Corporation of Valley Forge, Pennsylvania.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF CLAIMS

Claims 2 and 9-19 have been canceled. Claims 1 and 3-8 are active, finally rejected, and appealed.

IV. STATUS OF AMENDMENTS

All amendments have been entered.

V. SUMMARY OF THE INVENTION

The present invention relates generally to a method for inserting an item into a receptacle. (Page 1, lines 7-8.) The present invention provides a method for inserting an item into a receptacle without fraying, bending, or otherwise damaging the item. The method provides for the neat insertion of the item into the receptacle to produce a final product that is aesthetically pleasing to the consumer. (Page 2, lines 4-7.) The aesthetics of the final packaged product is important, since the ultimate consumer will take the aesthetics of the final product into account during the process of deciding which product among several competing products the consumer wishes to purchase. Therefore, aesthetics of the final packaged product can have a significant impact on the success of a product in the marketplace, especially when an item is packaged within a transparent packaging material. Therefore, if the item is forced into the receptacle and the product becomes damaged or appears deformed within the packaging, the consumer may decide not to purchase that product, and may opt for a competing product. (Page 1, lines 19-26.)

The claimed inventions are methods for inserting an item into a receptacle. Figures 4A-4D of the present application depict an illustrative, non-limiting method of the present invention. As depicted in Figures 4A-4D, an item (12) that is a rolled, elongated sheet of material is inserted into a receptacle (70) using an apparatus (10) having a hollow cylindrical tube section (22) having a first opening (28) and a second opening (30) and a hollow flared

section (40) having a narrow opening (48) and a wide opening (46). The narrow opening (48) of the flared section (40) is connected to the first opening (28) of the tube section (22). (Figures 1-4D, page 4, lines 16-18 and 24-29, and page 5, lines 6-9.)

The methods comprise the steps of positioning a receptacle (70) over an exterior surface (24) of the cylindrical tube section (22) adjacent the second opening (30)(Figure 4A and page 7, lines 4-6), inserting the item (12) within the flared section (40) via the wide opening (46)(Figure 4B and page 7, lines 28-29), and sliding the item (12) through the narrow opening (48) of the flared section (40), through the cylindrical tube section (22), and within the receptacle (70)(Figures 4B-4D, and page 8, lines 6-7).

In a first method of the present invention, the elongated sheet of material is rolled such that a terminal edge (16) of the elongated sheet is located on an exterior surface of the rolled item (12). (Figures 4A-4D.) The first method further comprises the step of rotating the item (12) as the item (12) is inserted within the flared section (40). (Figure 4B and page 7, lines 32-33.) The item (12) is rotated in a direction opposite a direction of rolling of the item such that the terminal edge (16) of the elongated sheet is maintained flat against the exterior surface of the rolled item (12). (Page 7, line 32, through page 8, line 3.) The direction of rolling of the item (12) is defined as a direction of outward spiraling from an end (14) provided at a center of the rolled item (12). (Page 7, lines 11-14.) For example, in the method depicted in Figures 4A-4D the direction of rolling is counterclockwise (page 7, line 11-14) and the item (12) is rotated upon insertion in the flared section (40) in the clockwise direction (Figure 4B and page 7, lines 32-33), thus the terminal edge (16) of the rolled item(12) is maintained flat against the

exterior surface of the rolled sheet of material and the rolled item will be neatly inserted into the receptacle without any frayed or deformed edges (page 7, lines 21-27, and page 8, lines 3-5).

In a second method of the present invention, the method further comprises the step of rotating the item (12) as the item is inserted within the flared section (40).

In a third method of the present invention, the method further comprises the step of rotating the item (12) as the item is slid through the cylindrical tube section (22). (Figure 4C and page 8, lines 6-10.)

VI. ISSUE

Whether Claims 1 and 3-8 are not patentable as obvious under 35 U.S.C. § 103(a) over G.B. Patent No. 448,519 (Robinson et al.) in view of U.S. Patent No. 5,020,302 (Buchman et al.).

VII. GROUPING OF CLAIMS

For purposes of this appeal, Claims 1 and 3-8 are individually patentable as argued below and do not stand or fall together.

VIII. ARGUMENT

The final Office Action combines the teachings of Robinson et al. with the teachings of Buchman et al. in order to arrive at the inventions recited in Claims 1 and 3-8. However, the Examiner has committed reversible error in concluding in the final Official Action dated August 12, 2003, that the claimed invention is obvious over the cited prior art, as there is simply no motivation to make this combination.

The final Official Action cites Robinson et al. for the teachings of the subject matter recited in Claims 1, 3, 4, and 6, except for the teaching of the rotation of the article during insertion process into either the flared section or the tubular section. (The Appellants note that the Official Action makes no mention of the subject matter recited in dependent Claims 5, 7, and 8.) The Official Action expressly notes that Robinson et al. does not disclose rotating rotation of the article during insertion process into either the flared section or the tubular section. Buchman et al. is cited for the teaching of a rotation of "a rolled item in a roll inserter while rotating the rolled item in a direction opposite the direction of the roll from the center spiraling outward during an insertion operation...." The Official Action then concludes that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the rotating of a rolled product as taught by Buchman et al., in the invention of Robinson et al. in order to assist in the insertion process. However, the Appellants submit that such a combination would be contrary to the teachings of the cited references.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. (See M.P.E.P. §2143.) The Appellants submit that no motivation existed at the time of the invention to combine the reference teachings of Robinson et al. and Buchman et al.

A. There is no motivation to combine the teachings of Robinson et al. and Buchman et al. to reject Claim 1 and dependent Claims 5-8.

Independent Claim 1 recites a method for inserting an item into a receptacle using an apparatus having a hollow cylindrical tube section and a hollow flared section. The method includes the steps of positioning a receptacle over an exterior surface of the cylindrical tube section, inserting the item within the flared section, and sliding the item through a narrow opening in the flared section, through the cylindrical tube section, and within the receptacle. The item is a rolled, elongated sheet of material that is rolled such that a terminal edge of the elongated sheet is located on an exterior surface of the rolled item. The method of Claim 1 further comprises the step of rotating the item as the item is inserted within the flared section, where the item is rotated in a direction opposite a direction of rolling of the item such that the terminal edge of the elongated sheet is maintained flat against the exterior surface of the rolled item, where the direction of rolling of the item is defined as a direction of outward spiraling from an end provided at a center of the rolled item.

Robinson et al. describes a method of packing mattresses in bags or other containers. In the method described in Robinson et al., the article is rolled into a coiled form, and then the coiled article is inserted into one end of a tube to retain its coiled form and the article is pushed through the tube into a bag or container, which is located over the other end of the tube. During a discussion of the background of the invention, Robinson et al. states that it is customary to wrap mattresses in cloth or paper sheets by rolling them in with such sheet. Robinson et al. notes that a rolled mattress is extremely difficult to insert in a paper bag and if the mattress is previously tied then the package remain loose within the paper bag. (See page 1, lines 12-22.)

Thus, Robinson et al. teaches the use of the tube described therein which prevents the mattress from unrolling while it is entering the bag. (See page 2, lines 28-30.)

Buchman et al. describes a problem similar to that described in Robinson et al., however Buchman et al. teaches a very different method of solving this problem. Buchman et al. describes problems associated with inserting a roll of plastic bags into a packaging carton. Buchman et al. describes one method of inserting the rolled bags by manually inserting the bags, however such a method decreases the number of packages that can be formed in a given time (presumably due to human inefficiencies) and increases the total cost. Buchman et al. then describes a second method in which a machine is used to grip the outside of the roll of bags and automatically insert the roll into a carton. However, Buchman et al. indicates that a disadvantage of the second method is that the carton must necessarily be sufficiently large to accommodate the roll and the gripper mechanism so that the gripper can hold the roll until the roll is inside the carton, where the gripper then releases it. Buchman et al. notes that because the size of the carton must be overly large, more material must be used to form the carton, thus increasing the total cost of the carton, as well as increasing the space needed to transport and store the cartons. (See column 1, lines 9-34.)

Thus, Buchman et al. teaches a method of inserting a roll of material into a carton that does not include a gripping mechanism that grips the outside of the roll. Buchman et al. describes a method of inserting a roll of material into a carton that does not include any means on the outside of the roll to prevent the roll from unwrapping, since such a means would require an increase in the size of the carton, which would require more material to make the carton and increase the total cost of the carton and increase the space needed to transport and store the carton. (See column 1, lines 23-34.) Thus, Buchman et al. describes a method of inserting a

roll of material into a carton by gripping an inside of the roll and drawing the roll into the carton where the roll is released by the gripping mechanism. Buchman et al. describes a rotating device (126) that rotates the spindle (122) in the required direction to wind up the tail (142) of the roll (14) while the spindle (122) is being retracted, pulling the roll (14) into the carton (150). (See column 3, lines 57-60.)

Buchman et al. teaches away from the use of a device on the outside of the rolled item during insertion of the item into the carton, since the use of such a device would necessarily increase the size of the carton, thus increasing the cost of the carton and increasing the space needed to transport and store the carton. Thus, Buchman et al. clearly teaches away from the use of a metal tube (1) as described in Robinson et al. to prevent the item from unrolling (page 3, lines 108-110, of Robinson et al.), but instead opts for simply winding the roll upon direct insertion into a carton. The metal tube (1) of Robinson et al. would necessarily increase the size of the carton needed to receive the roll, thus increasing the cost of the carton and increasing the space needed to transport and store the carton, which is directly contrary to the teachings of Buchman et al..

Furthermore, Robinson et al. indicates that the method described therein solves the problems associated with previous insertion manners, thus the addition of the device described in Buchman et al. would be unnecessarily costly and complex. Robinson et al. implies that it provides a method that inserts a rolled item in a bag in a manner such that the outer surface is smooth and in an efficient manner, thus there is no need for the complex and costly device described in Buchman et al. Robinson et al. uses a simply ram to insert the rolled item into the bag. Such a ram would be ineffective in providing a rotation to the item as it is being inserted within the bag.

Thus, the Appellants submit that no motivation existed, prior to the present invention, for combining the teachings of Robinson et al. and Buchman et al.

The Appellants respectfully submit that the rejection is based on the improper application of hindsight considerations. It is well settled that it is impermissible simply to engage in hindsight reconstruction of the claimed invention, using Appellant's structure as a template and selecting elements from the references to fill in the gaps. *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). Recognizing, after the fact, that a modification of the prior art would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, 397 F.2d 1011, 154 USPQ 173 (CCPA 1967).

For the reasons discussed above, the Appellants submit that Claim 1 is patentable.

Regarding dependent Claims 5-8, as discussed above in detail with regard to Claim 1, the Appellants submit that no motivation existed at the time of the invention to combine the reference teachings of Robinson et al. and Buchman et al. Thus, dependent Claims 5-8 are patentable at least for the reasons stated above with regard to Claim 1. Furthermore, with regard to Claim 5, the Appellants note that the Official Action dated August 12, 2003, does not cite a reference for the teaching of a method including a step of aligning the item at a predetermined orientation within the receptacle, as recited in Claim 5. Additionally, the Official Action cites Robinson et al. for the teaching of a tube section mounted on a stationary structure (2), however, Robinson et al. expressly states that the stand or frame (2) is portable. (See page 1, lines 39-41.)

For the reasons discussed above, the Appellants submit that Claims 5-8 are patentable.

B. There is no motivation to combine the teachings of Robinson et al. and Buchman et al. to reject Claim 3.

Independent Claim 3 recites a method for inserting an item that is a rolled, elongated sheet of material into a receptacle using an apparatus having a hollow cylindrical tube section and a hollow flared section. The method includes the steps of positioning a receptacle over an exterior surface of the cylindrical tube section, inserting the item within the flared section, and sliding the item through a narrow opening in the flared section, through the cylindrical tube section, and within the receptacle. The method of Claim 3 further comprises the step of rotating the item as the item is inserted within the flared section.

As discussed above in detail with regard to Claim 1, the Appellants submit that no motivation existed at the time of the invention to combine the reference teachings of Robinson et al. and Buchman et al. As discussed in detail above, Buchman et al. clearly teaches away from the use of a metal tube (1) as described in Robinson et al., and thus one of skill in the art would not have been motivated to make the proposed combination. More specifically, the use of the metal tube (1) of Robinson et al. with the winding method of Buchman et al. would necessarily increase the size of the carton needed to receive the roll, thus increasing the cost of the carton and increasing the space needed to transport and store the carton, which is directly contrary to the teachings of Buchman et al. The Appellants respectfully submit that the rejection is based on the improper application of hindsight considerations.

For the reasons discussed above, the Appellants submit that Claim 3 is patentable.

C. There is no motivation to combine the teachings of Robinson et al. and Buchman et al. to reject Claim 4.

Independent Claim 4 recites a method for inserting an item that is a rolled, elongated sheet of material into a receptacle using an apparatus having a hollow cylindrical tube section and a hollow flared section. The method includes the steps of positioning a receptacle over an exterior surface of the cylindrical tube section, inserting the item within the flared section, and sliding the item through a narrow opening in the flared section, through the cylindrical tube section, and within the receptacle. The method of Claim 4 further comprises the step of rotating the item as the item is slid through the cylindrical tube section.

As discussed above in detail with regard to Claim 1, the Appellants submit that no motivation existed at the time of the invention to combine the reference teachings of Robinson et al. and Buchman et al. As discussed in detail above, Buchman et al. clearly teaches away from the use of a metal tube (1) as described in Robinson et al., and thus one of skill in the art would not have been motivated to make the proposed combination. More specifically, the use of the metal tube (1) of Robinson et al. with the winding method of Buchman et al. would necessarily increase the size of the carton needed to receive the roll, thus increasing the cost of the carton and increasing the space needed to transport and store the carton, which is directly contrary to the teachings of Buchman et al. The Appellants respectfully submit that the rejection is based on the improper application of hindsight considerations.

For the reasons discussed above, the Appellants submit that Claim 4 is patentable.

Appellant therefore respectfully submits that all of the claims are patentable, and so requests that the final rejection be REVERSED.

Respectfully submitted,

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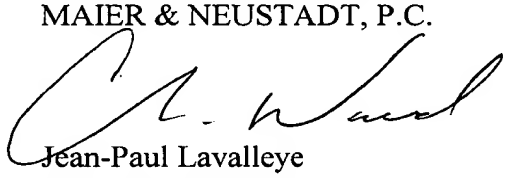

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APPENDIX

1. (Previously Presented) A method for inserting an item into a receptacle using an apparatus having a hollow cylindrical tube section having a first opening and a second opening and a hollow flared section having a narrow opening and a wide opening, the narrow opening being connected to the first opening, said method comprising the steps of:

positioning a receptacle over an exterior surface of the cylindrical tube section adjacent the second opening;

inserting the item within the flared section via the wide opening; and

sliding the item through the narrow opening of the flared section, through the cylindrical tube section, and within the receptacle,

wherein the item is a rolled, elongated sheet of material that is rolled such that a terminal edge of the elongated sheet is located on an exterior surface of the rolled item, and

wherein said method further comprises the step of rotating the item as the item is inserted within the flared section, where the item is rotated in a direction opposite a direction of rolling of the item such that the terminal edge of the elongated sheet is maintained flat against the exterior surface of the rolled item, where the direction of rolling of the item is defined as a direction of outward spiraling from an end provided at a center of the rolled item.

2. (Canceled)

3. (Previously Presented) A method for inserting an item that is a rolled, elongated sheet of material into a receptacle using an apparatus having a hollow cylindrical tube section having a first opening and a second opening and a hollow flared section having a narrow

opening and a wide opening, the narrow opening being connected to the first opening, said method comprising the steps of:

positioning a receptacle over an exterior surface of the cylindrical tube section adjacent the second opening;

inserting the item within the flared section via the wide opening; and

sliding the item through the narrow opening of the flared section, through the cylindrical tube section, and within the receptacle,

wherein said method further comprises the step of rotating the item as the item is inserted within the flared section.

4. (Previously Presented) A method for inserting an item that is a rolled, elongated sheet of material into a receptacle using an apparatus having a hollow cylindrical tube section having a first opening and a second opening and a hollow flared section having a narrow opening and a wide opening, the narrow opening being connected to the first opening, said method comprising the steps of:

positioning a receptacle over an exterior surface of the cylindrical tube section adjacent the second opening;

inserting the item within the flared section via the wide opening; and

sliding the item through the narrow opening of the flared section, through the cylindrical tube section, and within the receptacle,

wherein said method further comprises the step of rotating the item as the item is slid through the cylindrical tube section.

5. (Original) The method according to Claim 1, wherein said method further comprises the step of aligning the item at a predetermined orientation within the receptacle.

6. (Original) The method according to Claim 1, wherein said method further comprises the step of mounting said apparatus to a stationary structure.

7. (Original) The method according to Claim 1, wherein the receptacle is a bag.

8. (Original) The method according to Claim 1, wherein the receptacle is a sleeve.

9-19. (Canceled)